



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,719	04/13/2000	David R. Barstow	397/8	7194

26646 7590 11/18/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,719

Applicant(s)

BARSTOW ET AL.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 9/10/02.

This action is made Final.

2. In the amendment claims 1-16 are pending in the case. Claims 1, 5, 9 and 13 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 120, and based on U.S applications # 08/871,713 filed on 6/9/1997, 08/660,891 filed on 6/10/1996, 07/920,355 filed on 7/29/1992, 07/542,990 filed on 6/25/1990, and 07/641,716 filed on 1/15/1991, which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statements filed 4/13/00, 7/12/00 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

5. The rejections of claims 3, and 11 under the second paragraph of 35 U.S.C. 112 paragraph have been withdrawn as necessitated by the amendment.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1, 4-5, 8-9, 12-13, and 16 remain rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5, 2, 13, 2, 10, 2, 10, and 2 respectively of prior U.S. Patent No. 6,204,862 B1. This is a double patenting rejection, because the above claims are equivalent in scope, therefore the rejections are maintained.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action::

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2178

9. Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy et al, hereinafter McCarthy (Pat. # 4,894,774, 1/16/90), in view of Hughes et al, hereinafter Hughes (Pat. # 4,918,603, 4/17/90).

Regarding independent claim 1, McCarthy discloses a method for transmitting a game simulation; the simulation made up of sub-events—moving, colliding of objects, etc-- being governed by a set of rules—governing the motion of objects, collision detection, etc. The rules determine a status change—graphically moving, colliding of objects(col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67). McCarthy fails to explicitly disclose *simulation of a live event*. Hughes teaches the simulation of sports, such as a football game, on a computer (col.2, lines 1-67, and col.16,lines 3-9). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, because Hughes teaches above the simulation of an easy to use football game based on actual performances.

Moreover, McCarthy discloses representing one of the sub-events—moving, colliding of objects, etc—with action involving physical skill, and exertion—moving, colliding of objects(col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67).

Moreover, McCarthy discloses the creation, and updating of a database file for storing information concerning the game—moving, colliding of objects, etc— (col.2, lines 58-col.3, line 10).

Furthermore, McCarthy discloses the updating of array databases in response to moving of objects on a computer screen as per a user request or transmission (col.2, lines 58-col.3, line 10).

Art Unit: 2178

Regarding claim 2, which depends on claim 1, McCarthy discloses that the moving, and collision of objects is internally represented by a time slot—beginning and end time—and updating the database based upon the time slot (col.2, lines 58-col.3, line 67).

Claim 3 is directed towards a method for implementing the method found in claim 2, and therefore is similarly rejected.

Regarding claim 4, which depends on claim 1, McCarthy discloses that the moving, and collision of objects is represented by x, y coordinates (col.4, lines 6-67).

Furthermore, McCarthy discloses the creation, and updating of a database file for storing x, y coordinates regarding the moving and collision of objects (col.2, lines 58-col.3, line 10, and col. 8, lines 17-67).

Regarding independent claim 5, the limitations *of a method for transmitting information useful in a computer simulation of a live event....updating the database file* are directed towards the step of claim 1 and therefore are similarly rejected.

Furthermore, McCarthy discloses a method for transmitting a game simulation; the simulation made up of sub-events (col.1, lines 58-col.2, line 67, col.3, lines 56-col.4, line 67). McCarthy fails to explicitly disclose *receiving a request for information...from a viewer computer and transmitting information to the viewer computer*. Hughes teaches the request for the display of menus on a computer, including information about a football game, in response to a user's request (col.2, lines 1-67, col.4,line 41-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of McCarthy, and Hughes, because Hughes teaches above the simulation of an easy to use football game based on actual performances.

Art Unit: 2178

Claims 6-16 are directed towards a method for implementing the method found in claims 2, 2, 4, 1-2, 2, 4, 1-2, 2 and 4 respectively, and therefore are similarly rejected.

Response to Arguments

10. Applicant's arguments filed 9/10/02 have been fully considered but they are not persuasive. The Applicants submit that Hughes does not simulate sports on a computer (p.9,L.8-16). The Examiner disagrees with this submission, because Hughes teaches the provision to users of simulation game data via a computer program (c.1,L.1-67,c.16,L.3-9).

Further, The Applicants submit that the Examiner did not provide a motivation to combine the teaching of McCarthy and Hughes (p.9,L.20-26). The Examiner disagrees with this submission, because Hughes teaches the having sports team/players compete and participate based on simulation game statistical data via a computer program (c.1,L.1-67,c.16,L.3-9).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2178

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Application/Control Number: 09/548,719


Page 8

Art Unit: 2178

Arlington, VA, Sixth Floor (Receptionist).

CBP

11/4/02


STEPHEN S. HONG
PRIMARY EXAMINER